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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,705	04/02/2004	Cary Lee Bates	RO91999020US2	1201
31647 7590 11/10/2009 DUGAN & DUGAN, P.C. 245 Saw Mill River Road Suite 309 Hawthorne, NY 10532				
EXAMINER				
ZHONG, JUN FEI				
ART UNIT		PAPER NUMBER		
2426				
MAIL DATE		DELIVERY MODE		
11/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/816,705

**Applicant(s)**

BATES ET AL.

**Examiner**

JUN FEI ZHONG

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Notice**

1. In view of the appeal brief filed on 8/14/2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. (Patent # US 5671267).

As to claim 1, August discloses a method of controlling a set top box comprising:

providing a set top box that can be controlled by a telephone line coupled to the set top box (e.g., the base unit 20 could be contained in the set top box 32) (see col. 9, lines 47-55; col. 10, lines 20-25, 45-65; Fig. 5);

receiving a telephone call from a calling party via the telephone line (see col. 10, lines 45-65);

controlling the set top box via at least one command transmitted by the calling party to the set top box during the telephone call, the controlling including directing the set top box to a television event in accordance with the at least one command (e.g., ordering the set top box tuning to certain channels (or not tuning to) by entering the predetermined codes) (see col. 7, lines 15-22; col. 8, lines 12-17, 55-62; col. 9, lines 23-46; col. 10, lines 45-65; Fig. 2, 3, and 5).

August does not specifically disclose the command includes directing the set top box to tune to a television event by the calling party.

August discloses the number keys are used to enter a desired channel number and the left and right arrows keys are for channel up/down. August also discloses a user can remotely control the same function from his or her residence. Thus, a user could access the set top box remotely and send channel change commands to the set top box (i.e., ordering the set top box tuning to

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certain channels or not tuning to by enter the predetermined codes via telephone) (see col. 7, lines 15-22; col. 8, lines 12-17, 55-62; col. 9, lines 23-46; col. 10, lines 45-65; Fig. 2, 3, and 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the tuning command including in the remote control functions in order to provide a set top box that a user has fully control of the set top box over a telephone call.

As to claim 12, August discloses an apparatus adapted to employ a telephone interface (e.g., set top box 32; Fig. 5) comprising:

a processor (e.g., control unit 210; Fig. 2) comprising computer program code adapted to control a set top box via at least one command transmitted by a calling party over a telephone line coupled to the set top box, the command being transmitted during a telephone call (e.g., the base unit 20 could contained in the set top box 32) (see col. 9, lines 47-55; col. 6, lines 35-51; col. 7, lines 1-11), the controlling including directing the set top box to a television event in accordance with the at least one command (e.g., ordering the set top box tuning to certain channels (or not tuning to) by enter the predetermined codes) (see col. 7, lines 15-22; col. 8, lines 12-17, 55-62; col. 9, lines 23-46; col. 10, lines 45-65; Fig. 2, 3, and 5).

August does not specifically disclose the command includes directing the set top box to tune to a television event by the calling party.

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August discloses the number keys are used to enter a desired channel number and the left and right arrows keys are for channel up/down. August also discloses a user can remotely control the same function from his or her residence. Thus, a user could access the set top box remotely and send channel change commands to the set top box (i.e., ordering the set top box tuning to certain channels or not tuning to by enter the predetermined codes via telephone) (see col. 7, lines 15-22; col. 8, lines 12-17, 55-62; col. 9, lines 23-46; col. 10, lines 45-65; Fig. 2, 3, and 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the tuning command including in the remote control functions in order to provide a set top box that a user has fully control of the set top box over a telephone call.

As to claim 14, it contains the limitations of claim 1 and is analyzed as previously discussed with respect to claim 1 above.

As to claim 2, August discloses the method of claim 1 wherein controlling the set top box via at least one command transmitted by the calling party comprises receiving at least one predetermined number dialed by the calling party (e.g., number 0-9 for channel number) (see col. 8, lines 13-17; col. 10, lines 45-65; Fig. 3).

As to claims 3 and 4, August discloses the method of claim 1 wherein controlling the set top box comprises disabling and enabling the set top box (e.g., user can remotely enable or inhibit channels or signals reaching video receiving device 60; Fig. 5) (see col. 10, lines 45-65).

As to claim 5, August discloses the method of claim 1 wherein controlling the set top box comprises directing the set top box to decrease a volume of a television set coupled to the set top box (see col. 2, lines 56-64).

As to claim 13, claim 1 meets the limitation.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Doganata et al. (Patent # US 6772436 B1).

As to claim 6, note the discussion above, August does not specifically disclose using the television speaker for telephone speaker.

Doganata discloses the set top box to transmit an audio signal from the calling party over a speaker of the television set (see col. 4, lines 54-67; Fig. 1 and 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to using television speaker for telephone as taught by Doganata to the remotely control set top box of August because it

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enables TV viewers to participate in audio conferences that are linked to the programs that they are watching, without the need to dial in to a conference call (see col. 2, lines 15-18)

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Ellis et al. (Pub # US 2005/0028208 A1).

As to claim 7, note the discussion above, August does not specifically disclose playing the television audio over the telephone.

Ellis discloses directing the set top box to play at least an audio portion of a television event over the telephone line (see paragraph 0094, 0133; Fig.1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to play television audio as taught by Ellis to the remotely control set top box of August because it provides a program guide system that allows a user to adjust to the user settings of a plurality of program guides at different locations within a household from a single location (see paragraph 0013).

6. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Schuchman et al. (Patent # US 5640453).

As to claim 9, note the discussion above, August does not specifically disclose directing the set top box to record a television event.



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Schuchman discloses controlling the set top box comprises directing the set top box to record a television event (see col. 3, lines 29-36; Fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to control VCR through set top box as taught by Schuchman to the remotely control set top box of August because the subscriber's set-top box could command storage devices to record video services and a controlled data stream from the storage device (see col. 2, lines 38-42)

As to claim 10, Schuchman discloses the method of claim 9 wherein directing the set top box to record a television event comprises directing the set top box to transmit a record command to a video recording device (see col. 3, lines 29-36).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Brodigan (Patent # US 6219355 B1).

As to claim 11, note the discussion above, August does not specifically disclose directing the set top box to play a telephone message.

Brodigan discloses controlling the set top box comprises directing the set top box to play a telephone message previously recorded by the set top box (e.g., replay voice messages) (see col. 5, lines 31-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide voice message as taught by Brodigan

to the remotely control set top box of August because provide a much needed simplification of services, such as a customer may review voice messages, or even order an additional telephone line or change phone services with their set top box (see col. 2, lines 55-65).

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Claims 1-14 are rejected.
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakano et al. (Patent # US 5901366) is cited to teach using cordless telephone selecting video program.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUN FEI ZHONG whose telephone number is (571)270-1708. The examiner can normally be reached on M-F, 7:30~5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hirl can be reached on 571-272-3685. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JFZ

11/5/2009

/Joseph P. Hirl/  
Supervisory Patent Examiner, Art Unit 2426  
November 6, 2009